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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,671	09/08/2003	Deborah A. Langer	3217	2146

EXAMINER	
GOLOBOY, JAMES C	

ART UNIT	PAPER NUMBER
1714	

MAIL DATE	DELIVERY MODE
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THE LUBRIZOL CORPORATION
Patent Administrator
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Wickliffe, OH 44092-2298

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/657,671

Applicant(s)

LANGER ET AL.

Examiner

James Goloboy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,8-11,15-17,19 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1, 5, 8-11, 15-16, 19, 22 is/are rejected.
- 7) ☐ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The finality of the previous office action is withdrawn and the amendment of 5/21/07 has been made of record. Upon reconsideration, the notice of allowable subject matter in the previous office action has been withdrawn for several claims, and grounds of rejection are set forth below. The examiner regrets the delay.

Claim Rejections - 35 USC § 102

2. Claims 1, 5, 8-11, 15-16, 19, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Filippini (U.S. PG Pub. 2004/0176263)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The discussions of Filippini in paragraphs 7-8 of the office action mailed 10/31/06 and paragraph 3 of the office action mailed 4/17/07 are incorporated here by reference. The composition of Filippini anticipates the compositions of the current claims for the reasons discussed therein, specifically because Filippini teaches in paragraphs 140-145 that the composition can contain a dispersant-viscosity index improver, and in paragraphs 26 and 153-154 that the composition can comprise a corrosion inhibitor,

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meeting the limitations of the oil soluble dispersants, viscosity modifier, and corrosion inhibitors of claim 1.

The notice of allowable subject matter for claims 7 (now incorporated into claim 1) and 8-11 set forth in the previous office action is withdrawn because the antioxidants, metal deactivators, detergents, antifoams, and rust inhibitors recited in those claims are *optional* components of the emulsified composition, and the compositions of those claims are therefore anticipated by Filippini in the case where the concentrations of those components are 0%. The notice of allowable subject matter for claim 22 is withdrawn, as Filippini teaches in paragraph 156 that the ingredients of the emulsion are mixed at a temperature of about 10° to about 50° C. "About 10°" includes ambient temperature, as recited in claim 22, and therefore the temperature range of Filippini falls within the range of claim 22, and matches the lower endpoint. Filippini does not teach the pressure at which the ingredients are mixed; it is the examiner's position that the absence of such a teaching clearly indicates that the mixing can be carried out at atmospheric pressure, as recited in claim 22.

Allowable Subject Matter

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Filippini does not disclose an emulsifier with a number average molecular weight of 2300. Since Filippini qualifies as prior art under 35

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USC 102(e) and applicant has filed a statement of common ownership at the time of the invention, it cannot be used in an obviousness rejection under 35 USC 103.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James C. Goloboy
JCG

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